

PUBLIC VERSION

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VERIGY US, INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

VERIGY US, INC, a Delaware Corporation,

Plaintiff,

vs.

ROMI OMAR MAYDER, an individual;
WESLEY MAYDER, an individual; SILICON
TEST SYSTEMS, INC., a California Corporation;
and SILICON TEST SOLUTIONS, LLC, a
California Limited Liability Corporation,
inclusive,

Defendants.

Case No. C07 04330 RMW (HRL)

**DECLARATION OF COLIN G.
McCARTHY IN SUPPORT OF VERIGY'S
MOTION TO COMPEL PRODUCTION OF
DOCUMENTS FROM SILICON TEST
SYSTEMS INC. IN RESPONSE TO 4TH SET
OF REQUESTS FOR PRODUCTION**

Date: October 21, 2008
Time: 10 a.m.
Ctrm.: 2, 5th Floor
Judge: Hon. Howard R. Lloyd

Complaint Filed: August 22, 2007
Trial Date: None Set

**PUBLIC VERSION OF
HIGHLY CONFIDENTIAL – ATTORNEYS' EYES ONLY
DOCUMENT SUBMITTED UNDER SEAL**

1 I, Colin G. McCarthy, declare as follows:

2 1. I am an attorney licensed to practice law before all of the courts of the State of
3 California, and am an associate with the law firm of Bergeson, LLP, counsel of record for plaintiff
4 Verigy US, Inc. ("Verigy") in the above-captioned action. Except as to matters stated on
5 information and belief, which I am informed and believe to be true, I have personal knowledge of
6 the facts set forth in this declaration, and, if called to do so, I could and would competently testify
7 thereto.

8 2. Attached hereto as Exhibit A is a true and correct copy of Verigy's 4th Set of
9 Requests for Production of Documents to Defendants Silicon Test Systems, Inc. and Romi
10 Mayder, dated July 24, 2008. "Exhibit A" to the document requests is a report from Navigant
11 Consulting, Inc., the special master appointed by the Court in the Fall of 2007 following the
12 Court's issuance of a TRO in this case to examine the hard drive of a computer belonging to
13 defendant Romi Mayder. Verigy's Request No. 82 sought "Native file format versions of all
14 DOCUMENTS indicated by a star on the special master's report attached hereto as Exhibit A"

15 3. Attached hereto as Exhibit B is a true and correct copy of Defendants' Response to
16 Verigy's 4th Set of Requests for Production of Documents, dated August 25, 2008.

17 4. Attached hereto as Exhibit C is a true and correct copy of a document entitled
18 "Response to Subpoena served on Richard Foster," dated August 27, 2008. Although the
19 document has no numbered pages, some 33 pages in, under the heading "3. ALL DOCUMENTS
20 RELATING TO THIS LAWSUIT," the document includes the following text:

21 I have at various times acted as a consultant to Romi Mayder and/or STS, including
22 legal, business, and personal matters. I have been copied on documents where Mr. Mayder
23 has also copied his attorneys. Therefore, I do not intend to produce documents that I feel
24 would be attorney-client privileged. . . .

25 5. Attached hereto as Exhibit D is a true and correct copy of relevant portions of the
26 Deposition Transcript of Romi Mayder, dated August 21, 2008. Mayder was the company
27 designee on all topics listed in Verigy's Notice of Deposition of Silicon Test Systems, Inc. Under
28 F.R.C.P. 30(b)(6).

6. On or about September 5, 2008, I, along with my colleague, Donald P. Gagliardi,

1 met and conferred with Defendants' counsel, Tim Hale, by telephone regarding the subject matter
2 of this motion, namely, Requests Nos. 54 through 69, 71, 81 and 82 of Verigy's 4th Set of
3 Requests for Production of Documents. Counsel for Defendants claimed that, notwithstanding the
4 assertions contained in the Romi Mayder and Thomas Schneck declarations, there has been no
5 waiver of the attorney-client privilege or work product doctrine, or that if such a waiver has
6 occurred, it is very limited in scope. Defendants' counsel also asserted that the document requests
7 relating to the assertions about advice of counsel were not relevant to any issue in the case and
8 constituted a "fishing expedition." The meet and confer session was unsuccessful in resolving the
9 parties' dispute concerning these document requests.

10 I declare under penalty of perjury under the laws of the United States of America that the
11 foregoing is true and correct and that this declaration was executed this 10th day of September,
12 2008 at San Jose, California.

13
14 /s/
Colin G. McCarthy

EXHIBIT A

CONFIDENTIAL

FILED UNDER SEAL

EXHIBIT B

1 JACK RUSSO (State Bar No. 96068)
2 TIM C. HALE (State Bar No. 114905).
3 JOHN KELLEY (State Bar No. 100714)
4 RUSSO & HALE LLP
5 401 Florence Street
6 Palo Alto, CA 94301
7 Telephone: (650) 327-9800
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9 Email: jrusso@computerlaw.com
10 thale@computerlaw.com
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12 Attorneys for Defendants and Counterclaimants
13 ROMI MAYDER, SILICON TEST SYSTEMS, INC.,
14 SILICON TEST SOLUTIONS, LLC and WESLEY
15 MAYDER

16 IN THE UNITED STATES DISTRICT COURT
17
18 IN AND FOR THE NORTHERN DISTRICT OF CALIFORNIA
19
20 SAN JOSE DIVISION

21 VERIGY US, INC., a Delaware Corporation,
22
23 Plaintiff,
24
25 v.

26 ROMI MAYDER, an individual; WESLEY
27 MAYDER, an individual; SILICON TEST
28 SYSTEMS, INC., a California Corporation;
and SILICON TEST SOLUTIONS, LLC, a
California Limited Liability Corporation,
inclusive,

Defendants.

AND RELATED COUNTERCLAIMS.

Case No. 5:07-cv-04330-RMW (HRL)

**DEFENDANT SILICON TEST SYSTEMS,
INC.'S RESPONSES AND OBJECTIONS
TO PLAINTIFF VERIGY US, INC.'S
FOURTH SET OF REQUESTS FOR
PRODUCTION OF DOCUMENTS**

Complaint Filed: August 22, 2007
Trial Date: December 8, 2008 (jury trial)
(Defendants have elected to reserve their jury
trial rights under F.R.C.P., Rule 38)

1 PROPOUNDING PARTY: Plaintiff VERIGY US, INC.

2 RESPONDING PARTY: Defendant SILICON TEST SYSTEMS, INC.

3 SET NO.: FOUR (4)

4 Defendant SILICONT TEST SYSTEMS, INC. ("STS") herby responds to the Fourth
5 Request for Production of Documents (collectively, the "Requests;" severally, each "Request")
6 from plaintiff Verigy US, Inc. ("Verigy") as follows:

7 **GENERAL OBJECTIONS**

8 1. STS objects to each Request to the extent that it seeks disclosure of information that
9 is protected by the attorney-client privilege and/or the work product doctrine, and STS shall not
10 provide any such privileged information. STS understands the Requests not to encompass
11 privileged documents created after the filing of the action by Verigy (e.g., emails between STS and
12 any of its legal counsel in this action, past or current) and STS shall neither produce nor include
13 such documents in a privilege log.

14 2. STS objects to each Request to the extent responsive documents are in the
15 possession, custody, or control of other persons, that are publicly available, or that are already in
16 Verigy's possession, custody or control and, because such documents may be obtained more
17 readily by Verigy from its own sources, as being unwarranted, oppressive, and unduly burdensome.
18 STS further specifically objects to the purported instruction that it produce documents that are
19 possessed by "former officers, directors, employees, agents or representatives, including, but not
20 limited to, its attorneys." STS will not produce documents possessed by such former persons or its
21 attorneys.

22 4. STS objects to the definition of "DEFENDANTS to the extent that it that it includes
23 its "attorneys" and therefore requires that (a) STS provided documents and things outside its
24 possession, custody, or control and (b) calls for production of documents protected by the attorney-
25 client, work product or other applicable law, statute or doctrine of privilege.

26 5. STS objects generally to each Request to the extent that it would violate any
27 individual's right to privacy and/or violate the confidentiality provisions of any contract(s). STS
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1 will not produce any documents where such production would violate an individual's right to
2 privacy and/or violate the confidentiality provisions of any contract(s).

3 6. STS objects generally to each Request to the extent it is overly broad and unduly
4 burdensome, and to the extent it seeks information that is neither relevant to the disputed issues in
5 this action nor reasonably calculated to lead to the discovery of admissible evidence.

6 7. STS objects to each Request to the extent that it purports to impose burdens on STS
7 that are inconsistent with, or not otherwise authorized by, the Federal Rules of Civil Procedure
8 ("FRCP"). STS will construe and respond to each Request in a manner consistent with the FRCP
9 and not otherwise.

10 8. STS objects to each Request to the extent that it is vague, ambiguous, or
11 unintelligible.

12 9. STS objects to each Request to the extent that it seeks information or material that
13 is not relevant to the issues in dispute in this action, or that are not reasonably calculated to lead to
14 the discovery of relevant documents or information in this action.

15 10. STS objects to each Request as burdensome and oppressive to the extent it purports
16 to obligate STS to re-produce documents previously produced or made of record in this action, and
17 STS declines such re-production. STS objects to the entire set of Requests as unduly burdensome
18 and oppressive in light of Verigy's having served such Requests while a prior document request
19 was still pending.

20 11. STS objects to the purported instruction that it identify persons in possession of
21 certain documents as placing burdens upon STS not placed upon it by the FRCP, and STS shall not
22 do so.

23 12. STS objects to the purported instruction that it provide information about
24 documents it previously possessed as placing burdens on STS not placed upon it by the FRCP, and
25 STS shall not do so.

26 These General Objections shall be deemed to be incorporated in full into the response to
27 each specific response to the Requests set forth below and any responses are subject to the
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1 limitations and objections set forth herein, and are without prejudice to STS's rights with respect
2 hereto.

3 **RESPONSES TO REQUESTS FOR PRODUCTION**

4 **REQUEST FOR PRODUCTION NO. 54:**

5 All DOCUMENTS RELATING TO or supporting the statement by DEFENDANTS'
6 FORMER COUNSEL to ROMI MAYDER that DEFENDANTS "could continue to act in the
7 manner that resulted in the contempt filing" as described on page 17 of DEFENDANTS'
8 Memorandum of Points and Authorities in Support of Motion for Summary Adjudication and for
9 Modification of Preliminary Injunction, Docket No. 261, including, but not limited to,
10 COMMUNICATIONS between DEFENDANTS' FORMER COUNSEL and DEFENDANTS.

11 **RESPONSE:**

12 STS incorporates the General Objections set forth above. STS objects to this Request to
13 the extent that it seeks disclosure of privileged communications between attorney and client or
14 documents protected by the work product doctrine, and STS shall not produce any such privileged
15 documents. STS objects to this Request to the extent that it seeks production of documents in
16 violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the
17 California Constitution, or any other applicable doctrine, law, or statute of privilege. STS objects
18 to the definition of "DEFENDANTS' FORMER COUNSEL" to the extent that it includes "its
19 officers, directors, managers, employees, agents or attorneys" and therefore requires that (a) STS
20 provide documents and things outside its possession, custody, or control and (b) calls for
21 production of documents protected by the attorney-client privilege, work product doctrine or other
22 applicable law, statute or doctrine of privilege. STS objects to the definition of "DEFENDANTS
23 to the extent that it that it includes its "attorneys" and therefore requires that (a) STS provide
24 documents and things outside its possession, custody, or control and (b) calls for production of
25 documents protected by the attorney-client privilege, work product doctrine or other applicable
26 law, statute or doctrine of privilege. Subject to the objections set forth above, Defendants respond
27 that they have no such non-privileged documents.

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REQUEST FOR PRODUCTION NO. 55:

All DOCUMENTS RELATING TO or supporting the statement by DEFENDANTS' FORMER COUNSEL to ROMI MAYDER that DEFENDANTS' FORMER COUNSEL "could really not tell me what was in the various documents that comprise the Court's TRO," as described in the Declaration of Romi Mayder, filed July 10, 2008, Docket No. 261 ("MAYDER DECLARATION"), including, but not limited to, COMMUNICATIONS between DEFENDANTS' FORMER COUNSEL and DEFENDANTS.

RESPONSE:

STS incorporates the General Objections set forth above. STS objects to this Request to the extent that it seeks disclosure of privileged communications between attorney and client or documents protected by the work product doctrine, and STS shall not produce any such privileged documents. STS objects to this Request to the extent that it seeks production of documents in violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the California Constitution, or any other applicable doctrine, law, or statute of privilege. STS objects to the definition of "DEFENDANTS' FORMER COUNSEL" to the extent that it includes "its officers, directors, managers, employees, agents or attorneys" and therefore requires that (a) STS provide documents and things outside its possession, custody, or control and (b) calls for production of documents protected by the attorney-client privilege, work product doctrine or other applicable law, statute or doctrine of privilege. STS objects to the definition of "DEFENDANTS" to the extent that it includes its "attorneys" and therefore requires that (a) STS provide documents and things outside its possession, custody, or control and (b) calls for production of documents protected by the attorney-client privilege, work product doctrine or other applicable law, statute or doctrine of privilege. Subject to the objections set forth above, Defendants respond that they have no such non-privileged documents.

REQUEST FOR PRODUCTION NO. 56:

All DOCUMENTS RELATING TO the press release issued by DEFENDANTS referenced in paragraph 14 and Ex. 7 to the MAYDER DECLARATION, including, but not limited to, COMMUNICATIONS between DEFENDANTS' FORMER COUNSEL and DEFENDANTS.

RESPONSE:

STS incorporates the General Objections set forth above. STS objects to this Request to the extent that it seeks disclosure of privileged communications between attorney and client or documents protected by the work product doctrine, and STS shall not produce any such privileged documents. STS objects to this Request to the extent that it seeks production of documents in violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the California Constitution, or any other applicable doctrine, law, or statute of privilege. STS objects to the definition of "DEFENDANTS' FORMER COUNSEL" to the extent that it includes "its officers, directors, managers, employees, agents or attorneys" and therefore requires that (a) STS provide documents and things outside its possession, custody, or control and (b) calls for production of documents protected by the attorney-client privilege, work product doctrine or other applicable law, statute or doctrine of privilege. STS objects to the definition of "DEFENDANTS" to the extent that it includes its "attorneys" and therefore requires that (a) STS provide documents and things outside its possession, custody, or control and (b) calls for production of documents protected by the attorney-client privilege, work product doctrine or other applicable law, statute or doctrine of privilege. Subject to the objections set forth above, Defendants respond that they have no such non-privileged documents that have not been previously produced.

REQUEST FOR PRODUCTION NO. 57:

All DOCUMENTS RELATING TO the proposed NDA with VERIGY referenced in paragraph 15 and Exs. 8 and 9 to the MAYDER DECLARATION, including, but not limited to, COMMUNICATIONS between DEFENDANTS' FORMER COUNSEL and DEFENDANTS.

RESPONSE:

STS incorporates the General Objections set forth above. STS objects to this Request to the extent that it seeks disclosure of privileged communications between attorney and client or documents protected by the work product doctrine, and STS shall not produce any such privileged documents. STS objects to this Request to the extent that it seeks production of documents in violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the California Constitution, or any other applicable doctrine, law, or statute of privilege. STS objects

1 to the definition of "DEFENDANTS' FORMER COUNSEL" to the extent that it includes "its
 2 officers, directors, managers, employees, agents or attorneys" and therefore requires that (a) STS
 3 provide documents and things outside its possession, custody, or control and (b) calls for
 4 production of documents protected by the attorney-client privilege, work product doctrine or other
 5 applicable law, statute or doctrine of privilege. STS objects to the definition of "DEFENDANTS
 6 to the extent that it that it includes its "attorneys" and therefore requires that (a) STS provide
 7 documents and things outside its possession, custody, or control and (b) calls for production of
 8 documents protected by the attorney-client privilege, work product doctrine or other applicable
 9 law, statute or doctrine of privilege. Subject to the objections set forth above, Defendants respond
 10 that they have no such non-privileged documents that have not been previously produced.

11 **REQUEST FOR PRODUCTION NO.58:**

12 All DOCUMENTS RELATING TO or supporting the statement by DEFENDANTS'
 13 FORMER COUNSEL to ROMI MAYDER that DEFENDANTS could "continue to develop Flash
 14 Enhancer," referenced in paragraph 17 of the MAYDER DECLARATION, including, but not
 15 limited to, COMMUNICATIONS between DEFENDANTS' FORMER COUNSEL and
 16 DEFENDANTS.

17 **RESPONSE:**

18 STS incorporates the General Objections set forth above. STS objects to this Request to
 19 the extent that it seeks disclosure of privileged communications between attorney and client or
 20 documents protected by the work product doctrine, and STS shall not produce any such privileged
 21 documents. STS objects to this Request to the extent that it seeks production of documents in
 22 violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the
 23 California Constitution, or any other applicable doctrine, law, or statute of privilege. STS objects
 24 to the definition of "DEFENDANTS' FORMER COUNSEL" to the extent that it includes "its
 25 officers, directors, managers, employees, agents or attorneys" and therefore requires that (a) STS
 26 provide documents and things outside its possession, custody, or control and (b) calls for
 27 production of documents protected by the attorney-client privilege, work product doctrine or other
 28 applicable law, statute or doctrine of privilege. STS objects to the definition of "DEFENDANTS

1 to the extent that it that it includes its "attorneys" and therefore requires that (a) STS provide
 2 documents and things outside its possession, custody, or control and (b) calls for production of
 3 documents protected by the attorney-client privilege, work product doctrine or other applicable
 4 law, statute or doctrine of privilege. Subject to the objections set forth above, Defendants respond
 5 that they have no such non-privileged documents.

6 **REQUEST FOR PRODUCTION NO. 59:**

7 All DOCUMENTS RELATING TO or supporting the statement by DEFENDANTS'
 8 FORMER COUNSEL to ROMI MAYDER that that [sic] "continuing work with Honeywell,
 9 Spansion and Intel under the TRO was proper because that was the status quo that the TRO was
 10 supposed to maintain,"" referenced in paragraph 17 of the MAYDER DECLARATION,
 11 including, but not limited to, COMMUNICATIONS between DEFENDANTS' FORMER
 12 COUNSEL and DEFENDANTS.

13 **RESPONSE:**

14 STS incorporates the General Objections set forth above. STS objects to this Request to
 15 the extent that it seeks disclosure of privileged communications between attorney and client or
 16 documents protected by the work product doctrine, and STS shall not produce any such privileged
 17 documents. STS objects to this Request to the extent that it seeks production of documents in
 18 violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the
 19 California Constitution, or any other applicable doctrine, law, or statute of privilege. STS objects
 20 to the definition of "DEFENDANTS' FORMER COUNSEL" to the extent that it includes "its
 21 officers, directors, managers, employees, agents or attorneys" and therefore requires that (a) STS
 22 provide documents and things outside its possession, custody, or control and (b) calls for
 23 production of documents protected by the attorney-client privilege, work product doctrine or other
 24 applicable law, statute or doctrine of privilege. STS objects to the definition of "DEFENDANTS
 25 to the extent that it that it includes its "attorneys" and therefore requires that (a) STS provide
 26 documents and things outside its possession, custody, or control and (b) calls for production of
 27 documents protected by the attorney-client privilege, work product doctrine or other applicable

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1 law, statute or doctrine of privilege. Subject to the objections set forth above, Defendants respond
2 that they have no such non-privileged documents.

3 **REQUEST FOR PRODUCTION NO. 60:**

4 All COMMUNICATIONS between DEFENDANTS' FORMER COUNSEL and
5 DEFENDANTS relating to Dr. Blanchard, referenced in paragraph 19 of the MAYDER
6 DECLARATION.

7 **RESPONSE:**

8 STS incorporates the General Objections set forth above. STS objects to this Request to
9 the extent that it seeks disclosure of privileged communications between attorney and client or
10 documents protected by the work product doctrine, and STS shall not produce any such privileged
11 documents. STS objects to this Request to the extent that it seeks production of documents in
12 violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the
13 California Constitution, or any other applicable doctrine, law, or statute of privilege. STS objects
14 to the definition of "DEFENDANTS' FORMER COUNSEL" to the extent that it includes "its
15 officers, directors, managers, employees, agents or attorneys" and therefore requires that (a) STS
16 provide documents and things outside its possession, custody, or control and (b) calls for
17 production of documents protected by the attorney-client privilege, work product doctrine or other
18 applicable law, statute or doctrine of privilege. STS objects to the definition of "DEFENDANTS
19 to the extent that it that it includes its "attorneys" and therefore requires that (a) STS provide
20 documents and things outside its possession, custody, or control and (b) calls for production of
21 documents protected by the attorney-client privilege, work product doctrine or other applicable
22 law, statute or doctrine of privilege. Subject to the objections set forth above, Defendants respond
23 that they have no such non-privileged documents.

24 **REQUEST FOR PRODUCTION NO. 61:**

25 All COMMUNICATIONS between DEFENDANTS' FORMER COUNSEL and
26 DEFENDANTS relating to the Contempt Motion, referenced in paragraph 19-24 of the MAYDER
27 DECLARATION.

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RESPONSE:

STS incorporates the General Objections set forth above. STS objects to this Request to the extent that it seeks disclosure of privileged communications between attorney and client or documents protected by the work product doctrine, and STS shall not produce any such privileged documents. STS objects to this Request to the extent that it seeks production of documents in violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the California Constitution, or any other applicable doctrine, law, or statute of privilege. STS objects to the definition of "DEFENDANTS' FORMER COUNSEL" to the extent that it includes "its officers, directors, managers, employees, agents or attorneys" and therefore requires that (a) STS provide documents and things outside its possession, custody, or control and (b) calls for production of documents protected by the attorney-client privilege, work product doctrine or other applicable law, statute or doctrine of privilege. STS objects to the definition of "DEFENDANTS" to the extent that it includes its "attorneys" and therefore requires that (a) STS provide documents and things outside its possession, custody, or control and (b) calls for production of documents protected by the attorney-client privilege, work product doctrine or other applicable law, statute or doctrine of privilege. Subject to the objections set forth above, Defendants respond that they have no such non-privileged documents.

REQUEST FOR PRODUCTION NO. 62:

All COMMUNICATIONS between DEFENDANTS' FORMER COUNSEL and DEFENDANTS relating to the TRO, referenced in the MAYDER DECLARATION.

RESPONSE:

STS incorporates the General Objections set forth above. STS objects to this Request to the extent that it seeks disclosure of privileged communications between attorney and client or documents protected by the work product doctrine, and STS shall not produce any such privileged documents. STS objects to this Request to the extent that it seeks production of documents in violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the California Constitution, or any other applicable doctrine, law, or statute of privilege. STS objects to the definition of "DEFENDANTS' FORMER COUNSEL" to the extent that it includes "its

1 officers, directors, managers, employees, agents or attorneys” and therefore requires that (a) STS
 2 provide documents and things outside its possession, custody, or control and (b) calls for
 3 production of documents protected by the attorney-client privilege, work product doctrine or other
 4 applicable law, statute or doctrine of privilege. STS objects to the definition of “DEFENDANTS
 5 to the extent that it that it includes its “attorneys” and therefore requires that (a) STS provide
 6 documents and things outside its possession, custody, or control and (b) calls for production of
 7 documents protected by the attorney-client privilege, work product doctrine or other applicable
 8 law, statute or doctrine of privilege. Subject to the objections set forth above, Defendants respond
 9 that they have no such non-privileged documents.

10 **REQUEST FOR PRODUCTION NO. 63:**

11 All COMMUNICATIONS between DEFENDANTS’ FORMER COUNSEL and
 12 DEFENDANTS relating to the Preliminary Injunction motion and briefing, referenced in the
 13 MAYDER DECLARATION.

14 **RESPONSE:**

15 STS incorporates the General Objections set forth above. STS objects to this Request to
 16 the extent that it seeks disclosure of privileged communications between attorney and client or
 17 documents protected by the work product doctrine, and STS shall not produce any such privileged
 18 documents. STS objects to this Request to the extent that it seeks production of documents in
 19 violation of the confidentiality provisions of any contract(s), Defendants’ right of privacy under the
 20 California Constitution, or any other applicable doctrine, law, or statute of privilege. STS objects
 21 to the definition of “DEFENDANTS’ FORMER COUNSEL” to the extent that it includes “its
 22 officers, directors, managers, employees, agents or attorneys” and therefore requires that (a) STS
 23 provide documents and things outside its possession, custody, or control and (b) calls for
 24 production of documents protected by the attorney-client privilege, work product doctrine or other
 25 applicable law, statute or doctrine of privilege. STS objects to the definition of “DEFENDANTS
 26 to the extent that it that it includes its “attorneys” and therefore requires that (a) STS provide
 27 documents and things outside its possession, custody, or control and (b) calls for production of
 28 documents protected by the attorney-client privilege, work product doctrine or other applicable

1 law, statute or doctrine of privilege. Subject to the objections set forth above, Defendants respond
2 that they have no such non-privileged documents.

3 **REQUEST FOR PRODUCTION NO. 64:**

4 All COMMUNICATIONS between Schneck & Schneck and DEFENDANTS relating to
5 the Patent Disclosure attached as Exhibit B to the Declaration of Thomas Schneck, dated October
6 9, 2007 ("SCHNECK DECLARATION").

7 **RESPONSE:**

8 STS incorporates the General Objections set forth above. STS objects to this Request to
9 the extent that it seeks disclosure of privileged communications between attorney and client or
10 documents protected by the work product doctrine, and STS shall not produce any such privileged
11 documents. STS objects to this Request to the extent that it seeks production of documents in
12 violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the
13 California Constitution, or any other applicable doctrine, law, or statute of privilege. STS
14 incorporates the General Objections set forth above. STS objects to the definition of
15 "DEFENDANTS to the extent that it that it includes its "attorneys" and therefore requires that (a)
16 STS provide documents and things outside its possession, custody, or control and (b) calls for
17 production of documents protected by the attorney-client privilege, work product doctrine or other
18 applicable law, statute or doctrine of privilege. Subject to the objections set forth above,
19 Defendants respond that they have no such non-privileged documents.

20 **REQUEST FOR PRODUCTION NO. 65:**

21 All COMMUNICATIONS relating to any novelty search done by Schneck & Schneck
22 related to documents attached as Exhibits B, D, or E to the SCHNECK DECLARATION,
23 referenced in the SCHNECK DECLARATION.

24 **RESPONSE:**

25 STS incorporates the General Objections set forth above. STS objects to this Request to
26 the extent that it seeks disclosure of privileged communications between attorney and client or
27 documents protected by the work product doctrine, and STS shall not produce any such privileged
28 documents. STS objects to this Request to the extent that it seeks production of documents in

1 violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the
 2 California Constitution, or any other applicable doctrine, law, or statute of privilege. STS
 3 incorporates the General Objections set forth above. STS objects to the definition of
 4 "DEFENDANTS to the extent that it that it includes its "attorneys" and therefore requires that (a)
 5 STS provide documents and things outside its possession, custody, or control and (b) calls for
 6 production of documents protected by the attorney-client privilege, work product doctrine or other
 7 applicable law, statute or doctrine of privilege. Defendants object to the term
 8 "COMMUNICATIONS" as vague and ambiguous in not identifying the parties to any such
 9 communications. Subject to the objections set forth above, Defendants respond that they have no
 10 such non-privileged documents.

11 **REQUEST FOR PRODUCTION NO. 66:**

12 All COMMUNICATIONS between Schneck & Schneck and DEFENDANTS relating to
 13 the documents attached as Exhibits B, D or E to the SCHNECK DECLARATION.

14 **RESPONSE:**

15 STS incorporates the General Objections set forth above. STS objects to this Request to
 16 the extent that it seeks disclosure of privileged communications between attorney and client or
 17 documents protected by the work product doctrine, and STS shall not produce any such privileged
 18 documents. STS objects to this Request to the extent that it seeks production of documents in
 19 violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the
 20 California Constitution, or any other applicable doctrine, law, or statute of privilege. STS
 21 incorporates the General Objections set forth above. STS objects to the definition of
 22 "DEFENDANTS to the extent that it that it includes its "attorneys" and therefore requires that (a)
 23 STS provide documents and things outside its possession, custody, or control and (b) calls for
 24 production of documents protected by the attorney-client privilege, work product doctrine or other
 25 applicable law, statute or doctrine of privilege. Subject to the objections set forth above,
 26 Defendants respond that they have no such non-privileged documents.

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REQUEST FOR PRODUCTION NO. 67:

All DOCUMENTS relating to Mr. Pochowski's alleged "disavowal of inventorship" as described in paragraph 16 of the SCHNECK DECLARATION.

RESPONSE:

STS incorporates the General Objections set forth above. STS objects to this Request to the extent that it seeks disclosure of privileged communications between attorney and client or documents protected by the work product doctrine, and STS shall not produce any such privileged documents. STS objects to this request to the extent that it seeks production of documents in violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the California Constitution, or any other applicable doctrine, law, or statute of privilege. Subject to the objections set forth above, Defendants respond that all such non-privileged documents have previously been produced.

REQUEST FOR PRODUCTION NO. 68:

All COMMUNICATIONS with Schneck & Schneck relating to potential litigation between ROMI MAYDER and Mr. Robert Pochowski, as referenced in documents bates-labeled SITES001744-001748.

RESPONSE:

STS incorporates the General Objections set forth above. STS objects to this Request to the extent that it seeks disclosure of privileged communications between attorney and client or privileged attorney work product, and STS shall not produce any such privileged documents. STS objects to this request to the extent that it seeks production of documents in violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the California Constitution, or any other applicable doctrine, law, or statute of privilege. Defendants object to the term "COMMUNICATIONS" as vague and ambiguous in not identifying the parties to any such communications. Subject to the objections set forth above, Defendants respond that they have no such non-privileged documents.

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REQUEST FOR PRODUCTION NO. 69:

All COMMUNICATIONS with Schneck & Schneck relating to inventorship, as referenced in documents bates-labeled SITES001585-001586.

RESPONSE:

STS incorporates the General Objections set forth above. STS objects to this Request to the extent that it seeks disclosure of privileged communications between attorney and client or privileged attorney work product, and STS shall not produce any such privileged documents. STS objects to this request to the extent that it seeks production of documents in violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the California Constitution, or any other applicable doctrine, law, or statute of privilege. Defendants object to the term "COMMUNICATIONS" as vague and ambiguous in not identifying the parties to any such communications. Subject to the objections set forth above, Defendants respond that they have no such non-privileged documents.

REQUEST FOR PRODUCTION NO. 70:

All DOCUMENTS relating to the "matrix options" as referenced in document bates-labeled SITES001728-001733.

RESPONSE:

STS incorporates the General Objections set forth above. STS objects to this Request to the extent that it seeks disclosure of privileged communications between attorney and client or privileged attorney work product, and STS shall not produce any such privileged documents. STS objects to this request to the extent that it seeks production of documents in violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the California Constitution, or any other applicable doctrine, law, or statute of privilege. Subject to the objections set forth above, Defendants respond that all such non-privileged documents have previously been produced.

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REQUEST FOR PRODUCTION NO. 71:

All COMMUNICATIONS between ROMI MAYDER and Schneck & Schneck relating to Mr. Pochowski, as referenced in the documents bates-labeled SITES001744-001748, SITES001585-001586, and SITES001728-001733.

RESPONSE:

STS incorporates the General Objections set forth above. STS objects to this Request to the extent that it seeks disclosure of privileged communications between attorney and client or privileged attorney work product, and STS shall not produce any such privileged documents. STS objects to this request to the extent that it seeks production of documents in violation of the confidentiality provisions of any contract(s), Defendants' right of privacy under the California Constitution, or any other applicable doctrine, law, or statute of privilege. Subject to the objections set forth above, Defendants respond that they have no such non-privileged documents.

REQUEST FOR PRODUCTION NO. 72:

All PowerPoint presentations and draft PowerPoint presentations previously produced in this action in native file format.

RESPONSE:

STS incorporates the General Objections set forth above. STS objects to this Request as purporting to require the re-production of a substantial number of documents produced by any Defendant, which documents amount to over 50,000 in number, and in that regard as overly broad, unduly burdensome, and harassing. STS further objects to this Request as unduly burdensome, expensive and oppressive in light of Verigy's having previously asked for, and received, such documents in a different format, namely "searchable pdf," such that production in a third format is unreasonable. STS objects to this Request as lacking foundation to the extent it assumes that every document previously produced would have "metadata" associated with it. Subject to and without waiving the foregoing objections, STS responds that pursuant to agreement reached by counsel at the meet-and-confer on August 5, 2008, STS has already produced in native format all those non-privileged, documents which are available on the active operating system identified by a "*" on the Special Master's list of documents as appended to plaintiff's Fourth Request for Production of

1 Documents [a number of these documents were recovered by the special master using EnCase or
 2 other forensic recovery software and are not accessible without this software, and which STS
 3 identifies as not reasonably accessible pursuant to Fed. R. Civ. P. 26 (b)(2)(B)]. STS will also
 4 produce in response to this Request any reasonable number of powerpoint presentations
 5 specifically identified by author, date, and file name, which Plaintiff may assert as having
 6 attachments or information which are missing from STS's previous productions, or to which
 7 Plaintiff specifically requires access to native file metadata.

8 **REQUEST FOR PRODUCTION NO. 73:**

9 All word processing documents previously produced in this action in native file format.

10 **RESPONSE:**

11 STS incorporates the General Objections set forth above. STS objects to this Request as
 12 purporting to require the re-production of a substantial number of documents produced by any
 13 Defendant, which documents amount to over 50,000 in number, and in that regard as overly broad,
 14 unduly burdensome, and harassing. STS further objects to this Request as unduly burdensome,
 15 expensive and oppressive in light of Verigy's having previously asked for, and received, such
 16 documents in a different format, namely "searchable pdf," such that production in a third format is
 17 unreasonable. STS objects to this Request as lacking foundation to the extent it assumes that every
 18 document previously produced would have "metadata" associated with it. Subject to and without
 19 waiving the foregoing objections, STS responds that pursuant to agreement reached by counsel at
 20 the meet-and-confer on August 5, 2008, STS has already produced in native format all those non-
 21 privileged, documents which are available on the active operating system identified by a "*" on the
 22 Special Master's list of documents as appended to plaintiff's Fourth Request for Production of
 23 Documents [a number of these documents were recovered by the special master using EnCase or
 24 other forensic recovery software and are not accessible without this software, and which STS
 25 identifies as not reasonably accessible pursuant to Fed. R. Civ. P. 26 (b)(2)(B)]. STS will also
 26 produce in response to this Request any reasonable number of word processing documents
 27 specifically identified by author, date, and file name, which Plaintiff may assert as having
 28 //

1 attachments or information which are missing from STS's previous productions, or to which
 2 Plaintiff specifically requires access to native file metadata.

3 **REQUEST FOR PRODUCTION NO. 74:**

4 All Excel spreadsheets previously produced in this action in native file format.

5 **RESPONSE:**

6 STS incorporates the General Objections set forth above. STS objects to this Request as
 7 purporting to require the re-production of a substantial number of documents produced by any
 8 defendant, which documents amount to over 50,000 in number, and in that regard as overly broad,
 9 unduly burdensome, and harassing. STS further objects to this Request as unduly burdensome,
 10 expensive and oppressive in light of Verigy's having previously asked for, and received, such
 11 documents in a different format, namely "searchable pdf," such that production in a third format is
 12 unreasonable. STS objects to this Request as lacking foundation to the extent it assumes that every
 13 document previously produced would have "metadata" associated with it. Subject to and without
 14 waiving the foregoing objections, STS responds that pursuant to agreement reached by counsel at
 15 the meet-and-confer on August 5, 2008, STS has already produced in native format all those non-
 16 privileged, documents which are available on the active operating system identified by a "*" on the
 17 Special Master's list of documents as appended to plaintiff's Fourth Request for Production of
 18 Documents [a number of these documents were recovered by the special master using EnCase or
 19 other forensic recovery software and are not accessible without this software, and which STS
 20 identifies as not reasonably accessible pursuant to Fed. R. Civ. P. 26 (b)(2)(B)]. STS will also
 21 produce in response to this request any reasonable number of Excel spreadsheets specifically
 22 identified by author, date, and file name, which Plaintiff may assert as having attachments or
 23 information which are missing from STS's previous productions, or to which Plaintiff specifically
 24 requires access to native file metadata.

25 **REQUEST FOR PRODUCTION NO. 75:**

26 All sales projections for STS products.

27 **RESPONSE:**

28 STS incorporates the General Objections set forth above. STS objects to this Request to

the extent that it requires the production of privileged documents under the attorney-client, work product, or other applicable doctrine, or any right of privacy, and STS shall not provide any such privileged information. STS objects to this Request as unduly expensive and burdensome under Fed. R. Civ. P. Rule 26(b)(2)(B) in that additional documents may exist and be in the possession of third parties, but are not reasonably accessible to STS. STS understands this Request not to encompass privileged documents created after the filing of the action by Verigy (*e.g.*, emails between STS and any of its legal counsel in this action, past or current) and STS shall neither produce nor include such documents in a privilege log. STS objects to this Request as vague and ambiguous as to time and subject matter, and in that regard as overbroad and unduly burdensome. STS objects to this Request as seeking documents that are not relevant to the issues in dispute in this action, or that are not reasonably calculated to lead to the discovery of relevant documents or information in this action; specifically, STS objects to this Request as purporting to require the production of documents relating to any "STS product" which are not related to the claims or defenses of this action and about which Verigy has no right to discover. STS objects to this Request in its use of the undefined term "sales projections" and in that regard as vague and ambiguous. Subject to and without waiving the foregoing objections, STS responds that it will produce all reasonably accessible, non-privileged, responsive documents not previously produced by STS.

REQUEST FOR PRODUCTION NO. 76:

All profit projections for STS products.

RESPONSE:

STS incorporates the General Objections set forth above. STS objects to this Request to the extent that it requires the production of privileged documents under the attorney-client, work product, or other applicable doctrine, or any right of privacy, and STS shall not provide any such privileged information. STS objects to this Request as unduly expensive and burdensome under Fed. R. Civ. P. Rule 26(b)(2)(B) in that additional documents may exist and be in the possession of third parties, but are not reasonably accessible to STS. STS understands this Request not to encompass privileged documents created after the filing of the action by Verigy (*e.g.*, emails

1 between STS and any of its legal counsel in this action, past or current) and STS shall neither
 2 produce nor include such documents in a privilege log. STS objects to this Request as vague and
 3 ambiguous as to time and subject matter, and in that regard as overbroad and unduly burdensome.
 4 STS objects to this Request as seeking documents that are not relevant to the issues in dispute in
 5 this action, or that are not reasonably calculated to lead to the discovery of relevant documents or
 6 information in this action; specifically, STS objects to this request as purporting to require the
 7 production of documents relating to any "STS product" which are not related to the claims or
 8 defences of this action and about which Verigy has no right to discover. STS objects to this
 9 Request in its use of the undefined term "profit projections" and in that regard as vague and
 10 ambiguous. Subject to and without waiving the foregoing objections, STS responds that it will
 11 produce all reasonably accessible, non-privileged, responsive documents not previously produced
 12 by STS.

13 **REQUEST FOR PRODUCTION NO. 77:**

14 All market analyses for STS products.

15 **RESPONSE:**

16 STS incorporates the General Objections set forth above. STS objects to this Request to
 17 the extent that it requires the production of privileged documents under the attorney-client, work
 18 product, or other applicable doctrine, or any right of privacy, and STS shall not provide any such
 19 privileged information. STS objects to this Request as unduly expensive and burdensome under
 20 Fed. R. Civ. P. Rule 26(b)(2)(B) in that additional documents may exist and be in the possession of
 21 third parties, but are not reasonably accessible to STS. STS understands this Request not to
 22 encompass privileged documents created after the filing of the action by Verigy (e.g., emails
 23 between STS and any of its legal counsel in this action, past or current) and STS shall neither
 24 produce nor include such documents in a privilege log. STS objects to this Request as vague and
 25 ambiguous as to time and subject matter, and in that regard as overbroad and unduly burdensome.
 26 STS objects to this Request as seeking documents that are not relevant to the issues in dispute in
 27 this action, or that are not reasonably calculated to lead to the discovery of relevant documents or
 28 information in this action; specifically, STS objects to this request as purporting to require the

1 production of documents relating to any "STS product" which are not related to the claims or
 2 defences of this action and about which Verigy has no right to discover. STS objects to this
 3 Request in its use of the undefined term "market analyses" and in that regard as vague and
 4 ambiguous. Subject to and without waiving the foregoing objections, STS responds that it all
 5 reasonably-accessible, non-privileged, responsive documents have been previously produced by
 6 STS.

7 **REQUEST FOR PRODUCTION NO. 78:**

8 All projected or current valuations for STS.

9 **RESPONSE:**

10 STS incorporates the General Objections set forth above. STS objects to this Request to
 11 the extent that it requires the production of privileged documents under the attorney-client, work
 12 product, or other applicable doctrine, or any right of privacy, and STS shall not provide any such
 13 privileged information. STS objects to this Request as unduly expensive and burdensome under
 14 Fed. R. Civ. P. Rule 26(b)(2)(B) in that additional documents may exist and be in the possession of
 15 third parties, but are not reasonably accessible to STS. STS understands this Request not to
 16 encompass privileged documents created after the filing of the action by Verigy (e.g., emails
 17 between STS and any of its legal counsel in this action, past or current) and STS shall neither
 18 produce nor include such documents in a privilege log. STS objects to this Request as vague and
 19 ambiguous as to time and subject matter, and in that regard as overbroad and unduly burdensome.
 20 STS objects to this Request as seeking documents that are not relevant to the issues in dispute in
 21 this action, or that are not reasonably calculated to lead to the discovery of relevant documents or
 22 information in this action. STS objects to this Request in its use of the undefined terms "projected
 23 or current valuations" and in that regard as vague and ambiguous. Subject to and without waiving
 24 the foregoing objections, STS responds that it will produce all reasonably accessible, non-
 25 privileged, responsive documents not previously produced by STS.

26 **REQUEST FOR PRODUCTION NO. 79:**

27 All DOCUMENTS RELATING TO projected or current valuations for STS, including, but
 28 not limited to, DOCUMENTS showing the basis for such valuations.

RESPONSE:

STS incorporates the General Objections set forth above. STS objects to this Request to the extent that it requires the production of privileged documents under the attorney-client, work product, or other applicable doctrine, or any right of privacy, and STS shall not provide any such privileged information. STS objects to this Request as unduly expensive and burdensome under Fed. R. Civ. P. Rule 26(b)(2)(B) in that additional documents may exist and be in the possession of third parties, but are not reasonably accessible to STS. STS understands this Request not to encompass privileged documents created after the filing of the action by Verigy (*e.g.*, emails between STS and any of its legal counsel in this action, past or current) and STS shall neither produce nor include such documents in a privilege log. STS objects to this Request as vague and ambiguous as to time and subject matter, and in that regard as overbroad and unduly burdensome. STS objects to this Request as seeking documents that are not relevant to the issues in dispute in this action, or that are not reasonably calculated to lead to the discovery of relevant documents or information in this action. STS objects to this Request in its use of the undefined terms "projected or current valuations" and in that regard as vague and ambiguous. Subject to and without waiving the foregoing objections, STS responds that it will produce all reasonably accessible, non-privileged, responsive documents not previously produced by STS.

REQUEST FOR PRODUCTION NO. 80:

All DOCUMENTS RELATING TO market analyses for STS.

RESPONSE:

STS incorporates the General Objections set forth above. STS objects to this Request to the extent that it requires the production of privileged documents under the attorney-client, work product, or other applicable doctrine, or any right of privacy, and STS shall not provide any such privileged information. STS objects to this Request as unduly expensive and burdensome under Fed. R. Civ. P. Rule 26(b)(2)(B) in that additional documents may exist and be in the possession of third parties, but are not reasonably accessible to STS. STS understands this Request not to encompass privileged documents created after the filing of the action by Verigy (*e.g.*, emails between STS and any of its legal counsel in this action, past or current) and STS shall neither

1 produce nor include such documents in a privilege log. STS objects to this Request as vague and
 2 ambiguous as to time and subject matter, and in that regard as overbroad and unduly burdensome.
 3 STS objects to this Request as seeking documents that are not relevant to the issues in dispute in
 4 this action, or that are not reasonably calculated to lead to the discovery of relevant documents or
 5 information in this action. STS objects to this Request in its use of the undefined term "market
 6 analyses" and in that regard as vague and ambiguous. Subject to and without waiving the
 7 foregoing objections, STS responds that it will produce all, non-privileged, responsive documents
 8 that have not been previously produced by STS.

9 **REQUEST FOR PRODUCTION NO. 81:**

10 Any receipt, bank statement, cancelled check, invoice, website print-out or packing slip
 11 showing any purchase made at bookfactory.com between May 2006 and January 2007.

12 **RESPONSE:**

13 STS incorporates the General Objections set forth above. STS objects to this Request as
 14 vague and ambiguous as to subject matter, and in that regard as overbroad and unduly burdensome.
 15 STS objects to this Request as seeking documents that are not relevant to the issues in dispute in
 16 this action, or that are not reasonably calculated to lead to the discovery of relevant documents or
 17 information in this action. STS objects to this as vague and ambiguous. Subject to and without
 18 waiving the foregoing objections, STS responds that it has no such documents not previously
 19 produced.

20 **REQUEST FOR PRODUCTION NO. 82:**

21 Native file format versions of all DOCUMENTS indicated by a star on the special master's
 22 report attached hereto as Exhibit A.

23 **RESPONSE:**

24 STS incorporates the General Objections set forth above. STS objects to this Request to
 25 the extent that it requires the production of privileged documents under the attorney-client, work
 26 product, or other applicable doctrine, or any right of privacy, and STS shall not provide any such
 27 privileged information. STS understands this Request not to encompass privileged documents
 28 created after the filing of the action by Verigy (*e.g.*, emails between STS and any of its legal

counsel in this action, past or current) and STS shall neither produce nor include such documents in a privilege log. STS objects to this Request as vague and ambiguous as to time and subject matter, and in that regard as overbroad and unduly burdensome. STS objects to this Request as seeking documents that are not relevant to the issues in dispute in this action, or that are not reasonably calculated to lead to the discovery of relevant documents or information in this action. STS further objects to this Request as unduly burdensome, expensive and oppressive in light of Verigy's having previously asked for, and received, such documents in a different format, namely "searchable pdf," such that production in a third format is unreasonable. STS objects to this Request as lacking foundation to the extent it assumes that every document previously produced would have "metadata" associated with it. Subject to and without waiving the foregoing objections, STS responds that pursuant to agreement reached by counsel at the meet-and-confer on August 5, 2008, STS has already produced in native format all those non-privileged, documents which are available on the active operating system identified by a "*" on the Special Master's list of documents as appended to plaintiff's Fourth Request for Production of Documents [a number of these documents were recovered by the special master using EnCase or other forensic recovery software and are not accessible without this software, and which STS identifies as not reasonably accessible pursuant to Fed. R. Civ. P. 26 (b)(2)(B)]. Further, STS has provided a privilege log as to those documents withheld on the basis of privilege.

Dated: August 25, 2008

RUSSO & HALE LLP

By:

Tim C. Hale /cg
Tim C. Hale

Attorneys for Defendants and Counterclaimants
ROMI MAYDER, SILICON TEST SYSTEMS, INC.,
SILICON TEST SOLUTIONS, LLC and WESLEY
MAYDER

EXHIBIT C

**HIGHLY
CONFIDENTIAL
ATTORNEYS' EYES
ONLY**

FILED UNDER SEAL

EXHIBIT D

CONFIDENTIAL

**ATTORNEYS'
EYES ONLY**

FILED UNDER SEAL